

III. REMARKS

Claims 1-9 are pending in this application. By this amendment, 1, 4 and 7 have been amended. The above amendments and the following remarks are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to present specific arguments regarding any rejected claims not specifically addressed. Further, Applicants reserve the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Entry of this Amendment is proper under 37 C.F.R. §1.116(b) because the Amendment: (a) places the application in condition for allowance as discussed below; (b) does not raise any new issues requiring further search and/or consideration; and (c) places the application in better form for appeal. Accordingly, Applicants respectfully request entry of this Amendment.

In the Office Action, claims 1-3 were rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter; claims 1-9 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Applicants respectfully submit that the claimed subject matter is allowable for the reasons stated below.

1. Rejections under 35 U.S.C. §101

Applicants first note that in the Office Action, only claims 1-3 are rejected under 35 U.S.C. §101, but in the explanation of this rejection, the program product (claimed in claims 7-9 of the current invention) is also mentioned. Office Action at page 2. Applicants assume this is a

typographical error and claims 7-9 are not rejected under 35 U.S.C. §101, but respectfully request clarification.

Applicants submit that the claimed subject matter is statutory and thus respectfully request withdrawal of the rejections for the reasons stated below.

First, claims 1-3 contain practical utility. State St. Bank & Trust Co. v. Signature Fin. Group, 149 F.3d 1368, 1375 (Fed. Cir. 1998). Claim 1 includes, *inter alia*, “associating at least one component task with a person involved in the business process” and “determining... a conflicting task[.]” Associating tasks with persons and determining conflicting tasks can happen outside a computer and are not just the transformation of data within a computer. Associating tasks with persons and determining conflicting tasks are physical activities and are practical applications as required by the Examination Guideline for Computer-Implemented Invention. 1184 OG at 92 (1996). For example, in the situation of global business, a task might be associated with a person in a local branch; after the association, relevant information is submitted to a central computer system to check conflicts; after the central computer feeds back potential conflicts, the local manager determines whether the task associated with the person contains conflicts and if so further actions will be taken. That is, associating tasks and determining conflicts affect the business process and as a consequence create efficiency and productivity in the operation of the business process, which are obviously “useful, concrete and tangible result[s].” State Street, 149 F.3d at 1373. Applicants submit that the Office is confusing breadth for abstractness, which is improper. Office Action at page 3.

In the Office Action, the Office asserts that the determining step is “more like a question and answer response and not a clear transformation/ manipulation of data into a different state or matter.” Office Action at page 3. Applicants respectfully traverse this assertion. The

determining is, *inter alia*, a real physical activity and is a practical application of the data transformation/ manipulation (e.g., identifying) that happens in the computer system. Such a practical application is a transformation from intangible data to tangible activities and is statutory. It is incomprehensible how such a determining step is “like a question and answer response[,]” as asserted by the Office. *Id.* However, even if, assuming *arguendo*, it is “question and answer response,” as long as the determining is a practical application of the data transformation/ manipulation into physical activities (business process), the subject matter is statutory. *See State Street* and *Guideline*, *supra*.

Second, the claimed invention includes “a physical transformation outside the computer for which a practical application in the technological arts is disclosed in the specification.” *Guideline*, 1184 OG at 91. In the current invention, as claimed in claim 1, a physical business process is “[transformed] into computer processor readable electronic signals and data[,]” and “the computer processor readable electronic signals and data [are input] into a data storage mechanism[.]” Claim 1 of the current invention. That is, in the current invention, measurements of business process are transformed outside of the computer into computer data, where the data comprises signals corresponding to the business process which is external to the computer system. *Guideline*, 1184 OG at 91. A business process is obviously physical. *Id.* Comparable to the subject matter of *In re Abele*, the subject matter of the current invention is statutory. 684 F.2d 902 (C.C.P.A. 1982).

Third, the claimed invention is limited to a practical application within the technological arts. As claimed in claim 1, for example, the application of the current invention is limited to “determining conflicting assignments of tasks of a business process[.]” Applicants respectfully

submit that the Office is confusing the invention's broad application to any business process with lack of a tangible result and abstractness.

Fourth, Applicants thankfully acknowledge the Office's indication that in the prior listing of claims, the relationship between the electronic signals and data and the body of claims are not clearly specified. By this Amendment, Applicants revised claim 1 to specify the relationship. Applicants respectfully submit that the revision is provided for clarification and is not related to patentability of the currently claimed subject matter.

In view of the foregoing, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §101.

2. Rejections under 35 U.S.C. §112

In the Office Action, claims 1-9 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. By this Amendment, claims 1, 4 and 7 have been revised to facilitate allowance, although Applicants do not agree with the Office regarding these rejections. Accordingly, Applicants respectfully request withdrawal of the rejections.

Specifically, in the Office Action, the Office asserts that:

1) It's not clear what is the scope of the claimed invention. If it's "determining conflicting tasks of business process", it could have been completed with the 2nd step of "identifying ... conflicts with the component task". It appears that the scope of the invention deals with "conflicting assignment of task to employee" due to predetermined conflicting task component. The focus should be on assignment of task component to each person involved in the business process. --- Office Action at page 4.

Applicants respectfully submit that the identifying step does not complete the determination because identifying happens in a computer system and the task association and

determination can happen outside the computer system. See the above global business example. The determination takes place after an association is made and is carried out by comparing the associated tasks and component tasks that are identified to conflict with other component tasks in the identifying step. By contrast, identifying is carried out in a computer system without real association of tasks with persons. By this Amendment, 1, 4 and 7, nevertheless, have been revised, *inter alia*, as follows to adopt the Office's suggestion: "determining conflicting assignment of tasks of a business process[.]"

2) it's not clear the relationship of "electronic signals and data representative of the business process" to the body of the claims since there is no discussion of the "... signals.. data .." in the body of the claim. --- Id.

Claim 1 has been revised, *inter alia*, to specify the relationship.

3) Claim 1, 2nd step recites the limitation "... with the component task". There is insufficient antecedent basis for this limitation in the claim. It appears that there is a 2nd dividing step of "dividing the component tasks into component task." -- Id.

Claims 1, 4 and 7 have been revised, *inter alia*, as follows: "identifying for a component task any other component task that conflicts with the component task[.]" (Emphasis ours).

4) Claim 1 recites the limitation "one assigned component task" in "(c) establishing..". There is insufficient antecedent basis for this limitation in the claim. Moreover, this step is vague and confused because it's written in inactive/passive state. -- Id.

Claims 1, 4 and 7 have been revised, *inter alia*, as follows: "associating at least one component task with a person involved in the business process[.]" Claim 1. Applicants submit

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that the specification (at page 10) provides support for this revision and no new matter has been added.

5) The last step "determining Other component tasks" is vague because it's not clear how this step is carried out by or by using what means. -- Id.

Applicants respectfully traverse this assertion. Claims 1, 4 and 7 includes, *inter alia*, "by comparing each associated component task with component tasks that are identified to conflict with other component tasks in the identifying step." This is, *inter alia*, a means for determining and makes it clear how the determining is carried out.

As in dep. claim 3 (part of 1), it's not clear the relationship between these three new steps to the claimed invention. -- Id.

Applicants respectfully submit that those three steps in claim 3 are specific embodiments for resolving conflicting assignments of tasks and are the reasonable consequences of the conflicting assignment determination.

In view of the foregoing, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §112, second paragraph.

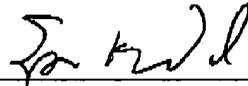
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Applicants respectfully submit that the application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in better condition for allowance, he is requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

Date:

1/13/05



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